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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,415	01/09/2001	Ming-Ming Zhou	2459-1-002N	6912

7590

05/26/2004

Klauber & Jackson
411 Hackensack Avenue
Hackensack, NJ 07601

EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,415	Applicant(s) ZHOU ET AL.	
	Examiner James Martinell	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 2, drawn to nucleic acids encoding amino acids 11-140 of SEQ ID NO: 1, classified in class 536, subclass 23.1.
- II. Claims 3 and 4, drawn to nucleic acids encoding 16-50 amino acids of SEQ ID NO: 5, classified in class 536, subclass 23.1.
- III. Claims 5 and 6, drawn to nucleic acids encoding 16-50 amino acids of SEQ ID NO: 3, classified in class 536, subclass 23.1.
- IV. Claims 7 and 8, drawn to polypeptides containing amino acids 11-140 of SEQ ID NO: 1, classified in class 530, subclass 350.
- V. Claims 9 and 10, drawn to polypeptides containing 16-50 amino acids of SEQ ID NO: 5, classified in class 530, subclass 324.
- VI. Claims 11 and 12, drawn to polypeptides containing 16-50 amino acids of SEQ ID NO: 3, classified in class 530, subclass 324.
- VII. Claim 13, drawn to methods for identifying stabilizing compounds by rational drug design using data from Tables 1-5, classified in class 702, subclass 19.
- VIII. Claim 14, drawn to methods for identifying destabilizing compounds by rational drug design using data from Tables 1-5, classified in class 702, subclass 19.
- IX. Claim 15, drawn to methods for identifying inhibitory compounds by rational drug design using data from Tables 1-5, classified in class 702, subclass 19.
- X. Claim 16, drawn to methods for identifying SNT/FGFR stabilizing compounds using data for amino acids 11-140 of SEQ ID NO: 1 and SEQ ID NO: 3 by rational drug design, classified in class 702, subclass 19.
- XI. Claim 17, drawn to methods for identifying SNT/FGFR destabilizing compounds using data for amino acids 11-140 of SEQ ID NO: 1 and SEQ ID NO: 3 by rational drug design, classified in class 702, subclass 19.

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- XII. Claim 18, drawn to methods for identifying compounds that inhibit formation of a SNT/FGFR complex using data for amino acids 11-140 of SEQ ID NO: 1 and SEQ ID NO: 3 by rational drug design, classified in class 702, subclass 19.
- XIII. Claim 19, drawn to methods for identifying compounds that potentially inhibit the SNT/FGFR dependent cellular signaling pathway using data from Tables 1-5, classified in class 702, subclass 19.
- XIV. Claim 20, drawn to methods for identifying compounds that potentially stimulate the SNT/FGFR dependent cellular signaling pathway using data from Tables 1-5, classified in class 702, subclass 19.
- XV. Claim 21, drawn to methods for identifying compounds that bind to the PTB domain of SNT1 or the SNT.FGFR complex using data from Tables 1-5, classified in class 702, subclass 19.
- XVI. Claim 22, drawn to a computer representation of SNT/FGFR complex using data from Tables 1-5, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons. The nucleic acids of each of Groups I-III are unrelated and thus each require a separate search and are independent and distinct one from the other. Likewise, the polypeptides of Groups IV-VI are unrelated and thus each require a separate search and are independent and distinct one from the other. The nucleic acids of Groups I-III are materially different from and are therefore independent and distinct from the polypeptides of Groups IV-VI and the computer systems of Group XVI. The polypeptides of Groups IV-VI are independent and distinct from the nucleic acids of Groups I-III and the computer systems of Group XVI. The nucleic acids of Groups I-III are not needed to practice any of the methods of Groups VII-XV. The nucleic acids of Groups I-III have uses other than as sources of data for the methods of Groups VII-XV (*e.g.*, in affinity chromatography). The polypeptides of Groups IV-VI are not needed to practice any of the methods of Groups VII-XV. The polypeptides of Groups IV-VI have uses other than as sources of data for the methods of Groups VII-XV (*e.g.*, in affinity chromatography). The methods of Groups VII-XV may

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be practiced independently of one another. The computer system of Group XVI is not required to perform any of the methods of Groups VII-XV and has uses other than in the methods of Groups VII-XV (*e.g.*, in the display of descriptive data).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

To search any two groups as outlined above would create an undue burden for the U.S. PTO because the searches of the non-patent literature are not only non-overlapping to any appreciable extent, but are also divergent in nature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Reminder Regarding *In re Ochiai* and *In re Brouwer*

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

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PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is
(703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should
be directed to the receptionist whose telephone number is (571) 272-1600.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631
5/24/07